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| APPLICATION NO.                                                    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--------------------------------------------------------------------|-------------|----------------------|------------------------------|------------------|
| 10/053,482                                                         | 11/02/2001  | Keith Wood           | 10743/3                      | 3594             |
| 757                                                                | 7590        | 11/04/2004           | EXAMINER<br>GITOMER, RALPH J |                  |
| BRINKS HOFER GILSON & LIONE<br>P.O. BOX 10395<br>CHICAGO, IL 60610 |             |                      | ART UNIT<br>1651             |                  |
|                                                                    |             |                      | PAPER NUMBER                 |                  |

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                                                    |                                                 |                                               |  |
|----------------------------------------------------|-------------------------------------------------|-----------------------------------------------|--|
| <p align="center"><b>Office Action Summary</b></p> | <p><b>Application No.</b></p> <p>10/053,482</p> | <p><b>Applicant(s)</b></p> <p>WOOD ET AL.</p> |  |
|                                                    | <p><b>Examiner</b></p> <p>Ralph Gitomer</p>     | <p><b>Art Unit</b></p> <p>1651</p>            |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 34-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 68-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

Applicant's election with traverse of Group I, claims 1-33, 68-78, in the reply filed on 10/18/04 is acknowledged. The traversal is on the ground(s) that the Office has failed to show that the method of Group III could be performed by hand without the kit of Group II. This is not found persuasive because methods may be practiced with or without kits.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-33, 68-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The core compound of formula XII is old. A preliminary search revealed too many citations to present here that read on the compounds as claimed. On page 19 of the present specification, formula XII is shown where R11, R14 or R15 is a cleavable protecting group and the structure is a protecting group on the carbonyl of a coelenterazine. A search reveals no references teach or fairly suggest the presently claimed core compound with one or more coelenterazine moieties. However, as claimed, R11, R14, or R15 can be anything except not all can be acetyl groups. Such compounds would not function as described and are old.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-33, 68-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

In claim 1 "enzyme-removable groups" is indefinite as it could read on H or a methyl group or most anything. This is so indefinite as to be unsearchable. Claim 3 fails to further limit claim 1 because the stated R groups are attached to O. In claim 6 F12 appears to be a trademarked name which is improper in claims. Claim 33 describes a compound in functional terms where one would not know the metes and bounds of the claim.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brynaert (WO 01/87853 A1) teaches compounds encompassed by the present claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone

Art Unit: 1651

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ralph Gitomer  
Primary Examiner  
Art Unit 1651

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JAN 11 2011